



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/664,800

09/19/2003

Gregory Scott Clark

215.1014.02

3481

22883 7590 03/17/2008
SWERNOFSKY LAW GROUP PC
P.O. BOX 390013
MOUNTAIN VIEW, CA 94039-0013

EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

2168

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/664,800	Applicant(s) CLARK, GREGORY SCOTT	
	Examiner CHEYNE D. LY	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' arguments filed December 19, 2007 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
2. Claims 1-6 have been withdrawn.
3. Claims 7-16 are examined on the merits.
4. The rejections of record have been withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 7 recites the limitation "said set of true proprietary part numbers" in 12. There is insufficient antecedent basis for this limitation in the claim. It is noted that line 10 recites "set of true part numbers" which does not provide clear antecedent basis for the limitation of set of true proprietary part numbers.
8. Further, line 12 recites "set of true proprietary part numbers" while line 15 recites "set of true part numbers" and the instant specification does not explicitly define true proprietary part numbers and true part numbers in order for one of ordinary skill in the art to distinguish

one from the other. The metes and bounds of the claims are not clear because one of ordinary skill in the art would be able to ascertain whether the true proprietary part numbers and true part numbers are distinct numbers or the same numbers.

9. Due the vague and indefinite issued discussed above, the limitations of the true proprietary part numbers and true part numbers have been interpreted reasonably broad.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinckley (US 2002/0055886 A1).

12. In regard to claims 7, 9, and 10, Hinckley a method for translating a document that includes a set of proprietary part numbers over a network (page 8, [0097], especially, “Bill of Materials...to electronically create, share...BOM line items may be translated...”), including the steps of receiving a first document (page 8, [0097], especially, “Bill of Materials...to electronically create, share...BOM line items may be translated...”) including a first set of proprietary part numbers from a client workstation (page 3, [0043], especially, “IPN” for internal part number, and [0045], especially, “an input/output interface”), wherein a user of said client workstation...

translating said first set of proprietary part numbers into a set of proprietary part numbers into a set of universal part numbers (page 5, [0063]-[0068], especially, “Universal Part Number (UPN)”),

determining availability of one or more parts associated with said set of universal part numbers (page 7, [0081]-[0084], especially, “the user wants to search...the MCR module may identify the corresponding UPN and capture records associated with the UPN);

storing in a first database a record of true part numbers and amounts of parts ordered or backordered (page 3, [0046], to page 4, [0047], e.g. Master Cross Reference data structure storing data...reference database...pending orders to identify a match based on component type, quantity, and price);

translating said set of true proprietary part numbers into numbers originally provided by the user (page 7, [0083], especially, “the MCR module may match all records that have the same UPN...return a listing of the unique IPN, CBs’ identification data MPN...”); and

generating shipping papers or electronic records (page 9, [0106], especially, “POs” and “invoices”).

13. However, Hinckley does not explicitly describe using the set of proprietary part numbers originally provided by the user translated from the set of true part numbers that summarizes a transaction involving the parts.

14. Hinckley describes an improvement that benefits component buyers (CBs) by reducing procurement cycle time and improved access to competitive pricing and available inventories (page 9, [0103]). “The order module may provide an integrated solution that enables CBs

and CSs [component sellers] to collaborate electronically with all of the trading partners in the supply chains...creating POs” (page 9, [0106]). Further, Hinckley describes the improvement “enable tracking IPN links to each CS and CB account.”

15. One of ordinary skill in the art at the time of the invention would have been motivated by the improvement of Hinckley to generate the second using the set of proprietary part numbers originally provided by the user translated from the set of true part numbers that summarizes a transaction involving the parts such as IPNs to reduce procurement cycle time and improve access to competitive pricing and available inventories by tracking IPN linked to each CS and CB account. Therefore, it would have been obvious to one of ordinary skill in the art to generate the second document using the second set of proprietary part numbers such as IPNs.

16. In regard to claim 8, Hinckley describes each of said set of universal part numbers is associated with other part numbers such as may be associated with different suppliers and manufactures (page 5, [0062]-[0063], especially, UPN and “associated MPN” (manufacture part number).

17. In regard claim 11, Hinckley describes identifying what parties may create associations between part numbers or enter new part numbers (page 6, [0061], especially, “register and store the identity(s) of entities providing such inaccurate data...allow the system and/or system operators or administrators to prioritize the equivalency data...).

18. In regard to claims 12-16, Hinckley describes the memory (page 1, [0008] and FIG 3).

CONCLUSION

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The

Art Unit: 2168

USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

22. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

/Cheyne D Ly/
Primary Examiner, Art Unit 2168